

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Michael Cafaro, et al.

Serial No.: 10/821,109

Filed: April 8, 2004

For: ION CURLING IRON AND
STRAIGHTENER

Group Art Unit: 3732

Examiner: Running, R.

Atty. Dkt. No.: HEL177/4-10US/78001

Confirmation No. 8231

REPLY TO EXAMINER'S ANSWER

**VIA EFS-WEB
ELECTRONIC FILING**

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

The present paper is filed in response to the Examiner's Answer mailed August 14, 2008,
and is in support of Appellants' Notice of Appeal filed May 19, 2008.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Michael Cafaro, et al.

Serial No.: 10/821,109

Filed: April 8, 2004

For: ION CURLING IRON AND
STRAIGHTENER

Group Art Unit: 3732

Examiner: Running, R.

Atty. Dkt. No.: HEL177/4-10US/78001

Confirmation No. 8231

CAFARO REPLY BRIEF

In their Appeal Brief, Appellants argued that the combination of the Leung and Nakagawa references does not disclose every feature of the claimed inventions. Brief, at 4-6. In particular, neither reference individually or in combination discloses “A hair styling device that heats the hair of a user by conduction of heat from a heated surface to the hair of a user.” *Id.*

In support of the rejection of Claims 1, 2, 4, 7, 9 and 10 based on Leung (U.S. Pat. Pub. No. 2003/0052115) in view of Nakagawa (U.S. Pat. Pub. No. 2002/0189128), the Examiner relies primarily on the statement in the Leung reference which reads in part “a cavity and a heatable surface with one or more vents.” Examiner’s Answer at 5 (citing Leung, ¶ 0015). At best this statement is ambiguous regarding which surface, but, if placed in its proper context, it is clear that the Leung reference does not meet every limitation of the claimed invention because it does not heat a user’s hair via conduction. The entire phrase from Leung reads “a cavity and a heatable surface with one or more vents **to release the heat from the barrel,**” which clearly indicates that heating the hair of a user through conduction is not contemplated. Leung, ¶ 0015 (emphasis added). Moreover, the Leung reference explicitly distinguishes between the “hot air curling iron” it discloses and “hair manipulating devices that employ an iron, i.e., a tube or barrel to heat and manipulate hair.” Leung, ¶ 0005. The Leung reference does not disclose “heat[ing]

the hair of a user by conduction of heat from a heated surface to the air of a user,” which means that the combination of Leung and Nakagawa does not disclose every claimed limitation.

The cited portion of the Lueng reference clearly shows that the Leung reference discloses a “hot air curling iron” and not the type of curling iron that heats hair via conduction. The Examiner’s Answer is based on the incorrect premise that the “heatable surface” described in the Leung reference is the outer surface and not the inner surface. Examiner’s Answer, at 5. However, this assumption is not supported by the Leung reference. Leung, ¶ 0015. As an initial matter, the Leung reference describes the presence of a cavity and then the presence of a “heatable surface.” *Id.* If the “heatable surface” was meant to refer to something other than the surface defining the cavity, then it most likely would have been listed as a separate element. Secondly, the Leung reference further describes “a heater extending through the cavity of the barrel, and a convector to direct heat from the heater through the vents of the barrel portion.” *Id.* Leung unambiguously describes the fact that heat is transmitted from the interior of the barrel to the exterior via the use of vents and not the surface of the barrel. The Examiner simply assumes that the exterior portion of the barrel is heated despite the fact that Leung distinguishes itself from those types of devices. *Compare* Examiner’s Answer at 5 *with* Leung, ¶ 0005. The Examiner’s Answer is based on a misreading of the Leung reference, consequently, Appellants ask the Board to overrule this rejection. Consequently, the rejection based on Leung in view of Nakagawa is improper and should be overturned.

In the Appeal Brief, Appellants argued that the combination of the Cha reference is not available as prior art based on the declaration of the Inventors which shows reduction to practice prior to the filing date of the Cha reference. Appeal Brief, at 6-8. The Examiner’s Answer is the first time that the sufficiency of Applicants’ declaration has been substantively presented to Appellants.

The Examiner rejected claims 1, 3-6 and 11-13 based on Cha (U.S. Pat. Pub. No. 2005/0056631) in view of Nakagawa (U.S. Pat. Pub. No. 2002/0189128). Applicants submitted a declaration that Appellants respectfully submit antedates the filing date of the Cha reference.

See April 18, 2008 Declaration, Exhibit C to Appeal Brief. Appellants respectfully note that the Examiner's Answer is the first time that the Examiner has substantively dealt with the sufficiency of Appellants Declaration to show reduction to practice prior to the filing date of the Cha reference. Examiner's Answer at 5. The December 18, 2007 Final Office Action rejected a declaration because it failed to explicitly allege acts in this country and was not signed by all inventors. 12/18/2007 Final Office Action, at 3. The March 19, 2008 Advisory Office Action rejected a declaration signed by all inventors that explicitly alleged acts in this country because it failed to include the evidence that had been submitted with prior declarations. 3/19/2008 Advisory Office Action, at 2. The May 2, 2008 Advisory Office Action rejected the declaration (attached as Exhibit C to Appellants' Appeal Brief) because "The evidence submitted is insufficient to establish Applicant's alleged conception and actual reduction to practice of the claimed invention [before] the effective date of the Cha reference," and "Applicant fails to establish due diligence from prior to the reference date to subsequent actual reduction to practice."¹ 5/02/2008 Advisory Office Action, at 1.

In response to the Examiner's arguments on the sufficiency of the disclosure attached to the Declaration, Appellants respectfully disagree with the Examiner's assessment of its sufficiency. In particular, the first page of submitted evidence is entitled "Ion Hair Styling Curling Iron and Flat Straightener." Exs. A & C, at 3. Moreover, the disclosure further states that "The negative ion system further includes a small DC motor with a fan that creates airflow to safely push the negative ions out the curling iron barrel or **the flat plates of the straightener** via small openings and safely onto the users' hair." *Id.* (emphasis added). Appellants recognize that the attached illustrates do not depict the claimed flat straightener configuration, however the disclosure accompanying the illustrations clearly demonstrates that Applicants were in

¹ Based on the Examiner's Answer, it appears that the Examiner has withdrawn the 37 C.F.R. § 1.116(e) objection to the April 18, 2008 Declaration. Examiner's Answer, at 5 ("The declaration filed April 18, 2008 under 37 CFR 1.131 has been considered...") Moreover, the Examiner appears to have withdrawn the rejection based on diligence as well.

possession of the invention claimed in Claims 1 3-6 and 11-13 prior to the filing date of the Cha reference. *Id.* More specifically, the Declaration demonstrates that Appellants were in possession of the “claimed specie” as well. *Id.* Consequently, Appellants respectfully submit that the Cha reference is not available as prior art based on the April 18, 2008 declaration and thus the rejection based on the Cha reference is improper and should be overturned.

Conclusion

Claims 1, 2, and 4, 7, 9 and 10 are patentable over Leung in view of Nakagawa because the combination of references does not disclose every limitation. Claims 1, 3-6, and 11-13 are patentable over Cha in view of Nakagawa because Cha is not prior art to the claimed invention. Consequently, Appellants ask the Board to overturn the rejection of all claims.

Respectfully submitted,

/s/ R. Floyd Walker

R. Floyd Walker

Reg. No. 55,707

Attorney for Applicants

Vinson & Elkins L.L.P.
2801 Via Fortuna, Suite 100
Austin, Texas 78746-7568
512.542.8453

Date: October 14, 2008